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09/679,212	10/04/2000	Deepak Gupta	JP920000252US1	8179

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/679,212

Applicant(s)

GUPTA, DEEPAK

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Detain Action***

1. This Office Action is in response to the Amendment A filed on 03/04/2004. Claims 1-24 have been amended and are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. Claim 2 recites the limitation "the extended parameter" in line 12 of page 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2141

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-4, 9-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinomura et al. (US 6,108,709), herein after referred as Shinomura, in view of McDowell et al. (US 6,438,583), herein after referred as McDowell.**

7. As to claims 1-2, Shinomura teaches a window (Fig. 14) containing a field "Alternate Name" for the sender to designate the terminal name, which specifies a user such as the user's name, user's account or address, the name of his or her terminal, or his or her nick name, that acts as an alternate receiver of an email message to be used in case the mail system can not deliver the message to the original recipient. Hence, Shinomura does teach an embedded "Alternate Recipient" parameter in the GUI (the panel of Fig. 14) to specify the alternative recipient for the system to automatically forward the message to the alternate recipients in case of inability to deliver to the original recipients (Shinomura, Fig. 14 and corresponding text, C13: L43-54).

However, Shinomura does not explicitly teach specifying the alternative recipient by addition of ARCPT (Alternate Recipient) parameter in the SMTP protocol.

In the related art, McDowell teaches a method and system for the re-routing of email sent to a prior address (or an address that is non-working, not available or temporarily inconvenient) to the new address of an intended recipient (*i.e., the alternate*

*address of the intended recipient)* through the SMTP implementation via software or hardware (*i.e., by additional parameter in the SMTP protocol*) (McDowell, C6: L20-29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Shinomura and McDowell to implement SMTP extensions by adding the extended ARCPT (Alternate Recipient) parameter in the SMTP protocol to automatically forward the message to the alternate recipients/receivers in case of inability to deliver to original recipients because it would let the system to take the advantage of the SMTP extension implementation (either via software or hardware) to allow the sender to define a back-up transmission path to increase the probability that the message reaches the final intended destination on the selected path (*i.e., through the alternate recipients/receivers*) in case of inability to deliver to original recipient without much effort required of a user.

8. As to claim 3, Shinomura-McDowell teaches the system as in claim 2, wherein the message is automatically forwarded to the alternate recipients in case of inability to deliver to the original recipients (alternate forwarding is automatically performed in accordance with alternate forwarding information registered in advance) (Shinomura, C6: L14-17).

9. As to claim 4, Shinomura-McDowell teaches the system as in claim 2, wherein the ARCPT parameter can also be used by the recipient or the system administrator of the recipient server to forward emails to another address and the alternate recipient on

the recipient server shall hold priority over the one already in the email specified by the sender (McDowell, C7: L11-49 and L63-67, C8: L1-23).

10. Claims 9-12 and 17-20 are corresponding method and computer program product claims of system claims 1-4; therefore, they are rejected under the same rationale.

**11. Claims 5-8, 13-16 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinomura-McDowell, in view of Buckley (US 6,163,809).**

12. As to claims 5-7, Shinomura teaches the invention substantially as claimed as discussed above; however, Shinomura does not explicitly teach a second extended keyword (ALTERNATE keyword) to an SMTP protocol parameter (NOTIFY parameter) for the sender to specify notification by said email system of successfully delivery to the alternate recipients on failure to deliver to original recipient and to notify the sender based on the delivery (or non-delivery) of the message to the alternate recipients.

In the related art, Buckley teaches a system and method for preserving delivery status notification wherein the sender defines delivery status notification options such as per-message options and/or per-recipient options (e.g., the option to identify for each recipient, i.e., both original recipients and alternate recipients, whether a message has been delivered or delayed, or whether delivery never occurred) through an extension of

the SMTP (*i.e., by addition of ALTERNATE keyword to the NOTIFY parameter*) (Buckley, C4: L13-24 and C7: L45-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Shinomura-McDowell and Buckley to implement SMTP extension to notify the sender based on the delivery (non-delivery) of the message to the alternate recipients/receivers because it would let the system to take the advantage of the extended SMTP implementation (either via software or hardware) to allow the sender to specify and receive delivery status notifications as requested in order to prevent loss of information transmitting over the networks by keeping track of the delivery (or non-delivery) of the message (*i.e., to keep track of whether the message reaches the final intended destination through the alternate recipients/receivers*) without much effort required of a user.

13. Claim 8 is a combination claim of claims 2 and 6; therefore, it is rejected under the same rationale.

14. Claims 13-16 and 21-24 are corresponding method and computer program product claims of system claims 5-8; therefore, they are rejected under the same rationale.

***Response to Arguments***

15. In the remarks, applicant argued in substance that

(A) Prior Arts do not teach the claimed extended parameter/keywords in the SMTP protocol.

As to point (A), **Shinomura** does teach an embedded "Alternate Recipient" parameter in the GUI (the panel of Fig. 14) to specify the alternative recipient for the system to automatically forward the message to the alternate recipients in case of inability to deliver to the original recipients (**Shinomura**, Fig. 14 and C13: L43-54).

In the related art, **McDowell** teaches a method and system for the re-routing of email sent to a prior address (or an address that is non-working, not available or temporarily inconvenient) to the new address of an intended recipient (*i.e., the alternate address of the intended recipient*) ***through the SMTP implementation*** either via software or hardware (*i.e., by adding an extended parameter in the SMTP protocol*) (**McDowell**, C6: L20-29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Shinomura** and **McDowell** to implement SMTP extensions by adding the extended ARCPT (Alternate Recipient) parameter in the SMTP protocol to automatically forward the message to the alternate recipients/receivers in case of inability to deliver to original recipients because



it would let the system to take the advantage of the SMTP extension implementation (either via software or hardware) to allow the sender to define a back-up transmission path to increase the probability that the message reaches the final intended destination on the selected path (i.e., through the alternate recipients/receivers) in case of inability to deliver to original recipient without much effort required of a user.

16. Applicant's arguments as well as request for reconsideration filed on 03/04/2004 have been fully considered but they are moot in view of the new ground(s) of rejection.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

A handwritten signature in black ink, appearing to read 'Le Hien Luu', is written over a horizontal line.

LE HIEN LUU  
PRIMARY EXAMINER